

REMARKS

The Office Action dated January 6, 2005, has been received and carefully considered. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

Applicants note with appreciation the indication on page 3 of the Office Action that claims 8-10 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have opted to defer rewriting the above-identified claims in independent form pending reconsideration of the arguments presented below.

I. **THE ANTICIPATION REJECTION OF CLAIMS 1-7 AND 11**

On page 2 of the Office Action, claims 1-7 and 11 were rejected under 35 U.S.C. § 102(e) as being anticipated by “PREMIERTM Anterior Cervical Plate System Surgical Technique.” (hereinafter the “Premium publication”). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. “In addition, the prior art reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” Id.

Regarding claims 1-7 and 11, the Examiner asserts that Fig. 21B [of the Premier publication] illustrates the plate. The Examiner further asserts that Figs. 23 and 24 illustrate a drill guide having first and second guide members extending from a handle. The Examiner further asserts that as shown in Fig. 24, the tips of the guide members comprise “offset portions.” The Examiner further asserts that the bevels of the guide members comprise intermediate portions or slot engaging ends, and that the offset portions may space the fastener any myriad of distances, including 1 millimeter, depending on the location of the guide relative to the upper edge of the elongated slot.

Applicants respectfully submit, however, that the Premier publication is not prior art against the pending claims. In support of such assertion, Applicants respectfully submit herewith the Declarations of Jennifer June (hereinafter the “June Declaration”) and the Declaration of Brian A. Burd under 35 U.S.C. §1.132 (hereinafter the “Burd Declaration”). The June and Burd Declarations are respectively attached hereto as Exhibits 1 and 2.

Applicants respectfully submit that the June Declaration affirmatively sets forth facts showing that the Premier publication was not published until after October 1, 2000. See June Declaration, ¶ 4. Applicants respectfully submit, therefore, that publication occurred within the one-year grace period preceding the earliest filing date of the above-referenced application, i.e., July 17, 2001.

Further, Applicants respectfully submit that the Burd Declaration affirmatively sets forth facts showing that the subject matter relied upon by the Examiner to reject the claims of the above-referenced application -- including the subject matter disclosed by Figures 21B, 23 and 24 of the Premier publication -- was invented by the inventors of the above-referenced application. See Burd Declaration, ¶ 4. Accordingly, Applicants respectfully submit that the Premier publication is not prior art to the pending claims.

In view of the foregoing, it is requested that the aforementioned anticipation rejection of claims 1-7 and 11 be withdrawn.

II. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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